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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,341	04/01/2004	Donald Wayne Howell	112325.133 US3	5348

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EXAMINER	
WACHSMAN, HAL D	
ART UNIT	**PAPER NUMBER**
2857	

DATE MAILED: 10/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/814,341	HOWELL ET AL.	
	Examiner	Art Unit	
	Hal D. Wachsman	2857	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 July 2005 and 17 August 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *25-51* is/are pending in the application.

4a) Of the above claim(s) *30-34,43,44,46 and 47* is/are withdrawn from consideration.

5)☒ Claim(s) *35-37,39,41 and 48-51* is/are allowed.

6)☒ Claim(s) *25,27,38,40 and 45* is/are rejected.

7)☒ Claim(s) *26,28,29 and 42* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *01 April 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. The examiner respectfully notes what appears to be a grammatical error in claim 35, line 12, "...at least *once* communication protocol". In addition, election was made without traverse of species I in the reply filed 11-8-04 however withdrawn claims 30-34, 43, 44, 46 and 47 have not been cancelled. Appropriate correction is required.

2. The reply filed 7-15-05 has a specification amendment that begins as "This application is a continuation of U.S. patent application..." indicated as being located at page 1, lines 1-3, of the specification. However, line 1 of page 1 of the specification contains the heading "BACKGROUND OF THE INVENTION" and line 2 of page 1 of the specification contains the heading "Related Applications". Appropriate correction is required.

3. The replacement Abstract in the reply filed 7-15-05 is objected to under 37 C.F.R. 1.72 because any new or replacement abstract must be submitted on a separate sheet. Appropriate correction is required.

4. Page 15 of the reply filed 7-15-05 states that the Applicants filed a terminal disclaimer in accordance with 37 C.F.R. 3.73(b). However, no terminal disclaimer has been found in the image file wrapper for the application and the facsimile transmittal sheet for that reply filed 7-15-05 indicated the attached forms being submitted to the USPTO as 1) Transmittal (1p.), 2) Petition for Extension of Time under 37 C.F.R. 1.136(a) (1p.) and 3) Response under 37 C.F.R. 1.111 (19pp. – none of these 19 pages contained a terminal disclaimer) and thus the facsimile transmittal sheet does not indicate that a terminal disclaimer was attached with the reply of 7-15-05. Appropriate correction is required.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 25 and 27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16 and 17 respectively of U.S. Patent No. 6,728,646. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 25 is anticipated by claim 16 of U.S. patent no. 6,728,646 because the load profile in claim 16 of the patent indicates the energy usage and the outputting of this load profile which indicates the energy usage which can encompass the use of a display as cited in claim

25 of the instant application. In addition, the feature of dependent claim 27 in the instant application and of dependent claim 17 in U.S. patent no. 6,728,646 are the same.

7. Claim 45 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,728,646. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 45 is anticipated by claim 1 of U.S. Patent No. 6,728,646 because as the sub-measurement board in claim 1 of the patent is connected to an energy distribution panel and receives the at least three voltage signals and at least nine current signals from the energy distribution panel, this would encompass the sub-measurement board including a means for receiving at least three voltage signals and at least nine current signals from the energy distribution panel.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. Claim 38 is rejected under 35 U.S.C. 102(e) as being anticipated by Johnson et al. (5,963,146).

As per claim 38, Johnson et al. (Abstract, figure 4, col. 11 lines 21-23) disclose "receiving metered utility data....said metered utility data being representative of utility usage at the location". Johnson et al. (Abstract, figures 1, 4, 11, col. 11 lines 31-37) disclose "processing the metered utility data". Johnson et al. (Abstract, figures 4, 5, col. 24 lines 6-12, col. 11 lines 21-25, col. 12 lines 30-45, col. 16 lines 20-35) disclose "outputting a cumulative, real-time measurement of usage of a customer's metered utilities".

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (5,963,146) in view of Kelley et al. (6,088,659).

As per claim 40, Johnson et al. (Abstract, figure 4, col. 11 lines 21-23) disclose "at least two utility meters, the at least two utility meters comprising an electric meter, a water meter, and a gas meter measuring the utility usage...and outputting a load profile of said utility usage". Johnson et al. (Abstract, figure 4, col. 11 lines 31-37) disclose " a wide area communications network responsively connected to said at least two utility meters which transfers the load profile to the energy information service provider". Johnson et al. (Abstract, figures 1, 4, 11, col. 11 lines 31-37) disclose "a processor system...which processes the load profile". It appears though that Johnson et al. does not clearly disclose "a gateway platform system including software and databases that enable translation of the load profile....into a format that is adapted for processing by the energy information service provider" and "wherein said load profile of said utility usage is accessible by the at least one customer in real-time". However,

Kelley et al. (Abstract, figures 16, 19B, 23C, col. 4 lines 65-67, col. 5 lines 48-51, col. 6 lines 9-25, col. 9 lines 30-43, col. 10 lines 12-14, col. 12 lines 14-29, col. 13 lines 24-27, col. 29 lines 2-4, col. 36 lines 9-15, 36-39, col. 50 lines 15-19, col. 51 lines 26-30, col. 52 lines 1-3) teach this excepted feature. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply the techniques of Kelley et al. to the invention of Johnson et al. as specified above because as taught by Kelley et al. (col. 5 lines 48-51) it would enable energy providers to capture consumption and interval meter data for hundreds of thousands of meters, deliver it directly to business functions like billing or CIS, and supply the data to large commercial and industrial accounts.

12. Claims 35-37, 39, 41 and 48-51 are allowed.

Claims 26, 28, 29 and 42 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. Applicant's arguments filed 7-15-05 have been fully considered but they are not persuasive with respect to the claims that remain rejected above. On page 15 of the reply filed 7-15-05 with respect to the obviousness-type double patenting rejections of claims 25 and 27, the Applicant argues that claim 25 further recites the limitation of "wherein said energy distribution panel includes a display for outputting said energy usage at the location" however again because the load profile in claim 16 of the 6,728,646 patent indicates the energy usage and the outputting of this load profile which indicates the energy usage that can still encompass the use of the display as now

claimed in claim 25 of the instant application. With respect to the argument concerning claim 45 and the terminal disclaimer, this has already been addressed in paragraph 4 above. On page 16 of the reply filed 7-15-05 with respect to claim 38, the Applicant argues that "...a customer can adjust usage based on this information" however with respect to this the Applicant is arguing an unclaimed merit or distinction. The Applicant further argues on this page that "In contrast, Johnson only teaches automating the reading of meters" however with respect to the underlined above the Applicant is arguing an unclaimed merit or distinction. The Applicant also states that "Specifically, Johnson teaches that "an essential sensor is for meter reading". However, if we turn to col. 11, lines 21-25, of the Johnson et al. reference, the complete sentences for this stated "An essential sensor is for meter reading, for ***measuring the amount of electricity, amount of water or amount of gas consumed.*** Such a sensor alleviates having a meter reader person, by allowing the system to **automatically report the amount of usage** of the physical device." Thus, it is quite clear from the above, a cumulative, real-time measurement of usage of the customer's metered utilities is being obtained. On page 16 of the reply filed 7-15-05, the Applicant also argues that "...Johnson teaches that the usage information is collected at time intervals" however with respect to this the Applicant is arguing an unclaimed merit or distinction. With respect to the arguments on page 17 of the reply filed 7-15-05 concerning claim 40 and the Kelley et al. reference, the Kelley et al. reference does teach the "..is accessible by the at least one customer in real-time" amended feature as shown in paragraph 11 above. With respect to the argument concerning the combination of the Johnson et al.

and Kelley et al. references on page 18 of the reply filed 7-15-05 the Examiner respectfully notes the following:

In response to applicant's argument that combining Johnson and Kelley only teaches an AMR server able to collect, load and manage system-wide data collected in time-intervals that are automatically read from energy meters, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

14. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hal D. Wachsman whose telephone number is 571-272-

2225. The examiner can normally be reached on Monday to Friday 7:00 A.M. to 4:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc Hoff can be reached on 571-272-2216. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hal D. Wachsman

Hal D Wachsman
Primary Examiner
Art Unit 2857

HW
October 9, 2005